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EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
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1624

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DATE MAILED: 12/14/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/712,129

Applicant(s)

STRUPCZEWSKI et al.

Examiner

Brenda Coleman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-75 and 77-147 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-75 and 77-147 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 1
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

Claims 1-75 and 77-147 are pending in the application.

#### *Reissue Applications*

1. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

- a) The oath/declaration fails to state that the applicants' are the original **and first** inventors.
- b) It does not identify the city and state or foreign country of residence of each inventor.
- c) The declaration does not recite error with sufficient specificity, i.e. what compounds are taught by the prior art.

2. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

3. Claims 1-75 and 77-147 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

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***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 78 and 82-86 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The definition of R where R is alkanoyl is not described in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 26, 59, 67-75, 77, 79, 80, 82-86, 98, 114 and 132-147 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a) Claims 1 (and claims dependent thereon) are missing a semicolon “:” after formula in the first line which appears in claim 1 of U.S. 5,364,866.
- b) Claims 1 (and claims dependent thereon) are missing a “CH” in the bracketed formula on page 2 of the preliminary amendment which appears in claim 1 of U.S. 5,364,866.

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- c) Claims 1 (and claims dependent thereon) include a comma after the  $-(CH_2)_n-$  in the definition of  $R_{20}$  which does not appear in claim 1 of U.S. 5,364,866.
- d) Claims 1 (and claims dependent thereon) include a hyphen "-" in the moiety  $-CH_2-C\equiv C-CH_2-CH_2-$  in line 1 of page 3 which does not appear in claim 1 of U.S. 5,364,866.
- e) Claims 1 (and claims dependent thereon) include a variable  $R_7$  in the definition of R on page 3 which does not appear in claim 1 of U.S. 5,364,866.
- f) Claims 1 (and claims dependent thereon) are missing a variable  $R^7$  in the definition of R which appears in column 112 of claim 1 in U.S. 5,364,866.
- g) Claims 26 (and claims dependent thereon) in U.S. 5,364,866 contain an unmatched open parenthesis and a close bracket in the nomenclature of the species.
- h) Claims 59 (and claims dependent thereon) recite the limitation "benzyloxy" in the nomenclature of the species. There is insufficient antecedent basis for this limitation in the claim.
- i) Claims 74 (and claims dependent thereon) recite the limitation "hydroxy and halogen groups" in the definition of Y. There is insufficient antecedent basis for this limitation in the claim.
- j) Claims 77 (and claims dependent thereon) recite the limitation  $-\text{NO}_3$  in the definition of R. There is insufficient antecedent basis for this limitation in the claim.

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- k) Claims 79 (and claims dependent thereon) are missing the “or” which appears after lower alkyl, in line 40 of column 118 of U.S. 5,364,866.
- l) Claims 79 (and claims dependent thereon) include an “or” in the definition of  $R_7$  on page 8 which does not appear in claim 79 of U.S. 5,364,866.
- m) Claims 80 (and claims dependent thereon) are missing a “CH” in the formula on page 9 which appears in claim 80 of U.S. 5,364,866.
- n) Claims 80 (and claims dependent thereon) include a comma after the  $-(CH_2)_n-$  in the definition of  $R_{20}$  which does not appear in claim 80 of U.S. 5,364,866.
- o) Claims 80 (and claims dependent thereon) include a variable  $R_7$  in the definition of R on page 10 which does not appear in claim 80 of U.S. 5,364,866.
- p) Claims 80 (and claims dependent thereon) are missing a variable  $R^7$  in the definition of R which appears in column 119 of claim 80 in U.S. 5,364,866.
- q) Claims 80 (and claims dependent thereon) include an “or” in the definition of R on page 10 which does not appear in claim 80 of U.S. 5,364,866.
- r) Claims 80 (and claims dependent thereon) are missing an “and” in the definition of R which appears in column 120 of claim 80 in U.S. 5,364,866.
- s) Claims 80 (and claims dependent thereon) include the moieties  $-C(=O)$ -aryl, or  $-C(=O)$ -heteroaryl in the proviso on page 11 which does not appear in claim 80 of U.S. 5,364,866.

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- t) Claims 80 (and claims dependent thereon) are missing the moieties -C(=O)-heteroaryl or -C(=W)-heteroaryl in the proviso which appears in column 120 of claim 80 in U.S. 5,364,866.
- u) Claims 82-86 are missing "any one of" before claims 1-75 and 77-81 which appears before "claims 1-81" in claims 82-86 of U.S. 5,364,866.
- v) Claim 98 recites the limitation "-NO<sub>3</sub>" in the definition of R. There is insufficient antecedent basis for this limitation in the claim.
- w) Claim 114 recites the limitation "-NO<sub>3</sub>" in the definition of R. There is insufficient antecedent basis for this limitation in the claim.
- x) Claims 132 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the "or" which appears before the moiety -CH(OR<sub>7</sub>)-alkyl indicating the end of the definition which is not so.
- y) Claims 142 (and claims dependent thereon) recite the limitation "-NO<sub>3</sub>" in the definition of R. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 78 and 82-86 are rejected under 35 U.S.C. 102(b) as being anticipated by Strupczewski et al., EP 402 644. EP 402 644 teaches the compounds, compositions and method of use of the compounds of the instant invention where X is O or S, n is 2, 3 or 4, R is hydrogen, hydroxyl, -C(=O)-n-butyl, -NHMe, -C(=O)-Et, ethoxy, -CH(OAc)-Me, -C(=O)-CF<sub>3</sub>, methyl, -NHAc, bromine, methoxy, acetyl, -CH(OAc)-Me, -CH(OEt)-Me and/or -CH(OH)-Me and Y is hydrogen, F or Cl. It is recognized benefit under 35 USC 120 is being urged. However, claims 78 and 82-86 of instant application are only entitled to benefit of serial number 07/969,383 filed October 30, 1992 as it is only completely described in the instant application. Note *In re Scheiber* 199 USPQ 782 regarding 112 compliance for benefit under 35 USC 120.

### ***Claim Objections***

7. Claims 82-86 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim must be in the alternative. See MPEP § 608.01(n).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is (703) 305-1880. The examiner can normally be reached on Mondays and Tuesdays from 9:00 AM to 3:00 PM and from 5:30 PM to 7:30 PM and on Wednesday thru Friday from 9:00 AM to 6:00 PM.

The fax phone number for this Group is (703) 308-4734 for "unofficial" purposes and the actual number for **OFFICIAL** business is **308-4556**.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

A handwritten signature in cursive script that reads "Brenda Coleman". The signature is written in black ink and is positioned above the printed name and title.

Brenda Coleman  
Primary Examiner AU 1624  
December 13, 2001